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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,402	11/25/2003	Koichi Takahara	19036/39735	1651

4743 7590 03/14/2005

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EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/721,402

Applicant(s)

TAKAHARA ET AL.

Examiner

Anthony J. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/04/04</u> . | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Response to Amendment***

1. The preliminary amendment submitted on 25 November 2003 has been entered.  
Currently claims 1-8 are pending.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the phrase "selected from the groups represented by the following formulae" is improper Markush terminology. The phrase should be changed to -- selected from the group consisting of -- and the term -- and -- should appear before the last formula which will overcome the rejection. Also the phrase "selected from ...and a naphthalene group" is improper Markush terminology. The phrase should be changed to -- selected from the group consisting of -- which will overcome the rejection.

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Claim 4 is confusing as written. It is unclear as to what is meant by the phrases "a base of the general formula (1) represented by the general formula (4)"; "of the general formula (2) represented by the general formula (5)"; "of the general formula (3) presented by the general formula (6)"; "of the general formula (1), the general formula (3) and the general formula (3), which is represented by the same general formula (7)". What does applicant mean by these phrases? Clarification is requested. The phrases "the general formula (1)", "the general formula (2)", and "the general formula (3)" appear to lack proper antecedent basis in claim 4 as nowhere in claim 4 are the formulae found for (1), (2) and (3). The phrase "selected from the groups represented by the following formulae" is improper Markush terminology. The phrase should be changed to -- selected from the group consisting of -- and the term -- and -- should appear before the last formula which will overcome the rejection. Also the phrase "selected from ... and a naphthalene group" is improper Markush terminology. The phrase should be changed to -- selected from the group consisting of -- which will overcome the rejection.

In claim 5 the phrase "which are synthesized separately from said monoazo yellow base pigment" is vague and indefinite. What is meant by this phrase? Also, how are they synthesized from the base pigment?

The preamble of claim 7 appears to be inconsistent with claim 2 as claim 2 is not directed to a process but rather a composition. The phrase "which are synthesized separately from said monoazo yellow base pigment" is vague and indefinite. What is meant by this phrase? Also, how are they synthesized from the base pigment?

***Information Disclosure Statement***

5. The references cited by applicant have been considered however they are not seen to teach and/or fairly suggest the instant invention. It is noted that according to the search report submitted, US 3759733 and JP07-126546 are cited as "Y" references (particularly relevant if combined with another) however based upon the abstract of JP07-126546 it appears that this reference does not fairly teach or suggest the instant invention. The examiner has requested a full translation of this reference and reserves the right to reject the claims over this reference if necessary in the next office action.

***Allowable Subject Matter***

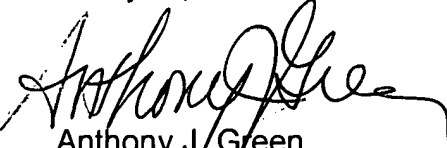
6. Claims 1-8 appear to be allowable the prior art as the prior art does not appear to teach and/or fairly suggest the instant composition and process. This indication of allowable subject matter is, however, contingent upon the receipt of a translation of JP07-126546 which has been requested by the examiner (See Item #5 above).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg  
March 07, 2005